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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,292	11/14/2003	Nicholas Ashworth	502302	1155
23626	7590	12/08/2004	EXAMINER	
LEYDIG VOIT & MAYER, LTD 6815 WEAVER ROAD ROCKFORD, IL 61114-8018			NORMAN, MARC E	
			ART UNIT	PAPER NUMBER
			3744	

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,292

Applicant(s)

ASHWORTH ET AL.

Examiner

Marc E. Norman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 13-20 is/are rejected.
- 7) ☒ Claim(s) 10-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/26/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-9 and 13-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cochran et al. in view of Dick et al. and Kim et al.

As per claims 1 and 16, Cochran et al. teaches a programmable thermostat comprising a user display screen, function selection means, and scrolling means (Figure 7). Cochran et al. does not teach displaying a service reminder message including a service organization name and phone number at the expiration of a reminder interval. However, service interval reminders are well-known in the art. Dick et al., for example, teaches a thermostat displaying a service reminder after a given interval (column 7, line 48 – column 8, line 13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the service

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reminder of Dick et al. to the thermostat of Cochran et al. for the simple purpose of insuring proper maintenance of the air conditioning system. The reminder of Dick et al. does not specifically teach the reminder including a service organization name and phone number. However, since this information is never functionally applied within the claim it is, in effect, non-functional descriptive matter and, as such, does not receive patentable weight. It is noted, however, that the display of service center contact information is old and well-known in the art. Kim et al., for example, teaches the display of a service center telephone number as part of a refrigeration system service message. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include such information in the display of Dick et al. for the purpose of assisting the user in case servicing of the system is required.

As per claims 2-4 and 18, Dick et al. further teaches the interval being settable based on a run time (column 7, line 48 – column 8, line 1).

As per claims 5, 6, 17, and 19, it is again noted that the information entered is non-functional descriptive matter and does not receive patentable weight. Nevertheless, since service persons typically set up all the basic information during system installation, it would be obvious for them to enter the contact information at that point.

As per claim 7, while Cochran et al. does not specifically teach soft keys, official notice is taken that soft keys are well-known features of thermostats that would have been obvious to apply to the thermostat of Cochran et al. for the simple purpose of providing convenient data entry.

As per claim 8, Cochran et al. teaches paired scroll keys (Figure 7).

As per claim 9, Dick et al. further teaches a visual display (e.g., “FILTER”).

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As per claim 13, Dick et al. further teaches an audible indicator (column 8, line 2).

As per claim 14, Dick et al. further teaches a delay function (column 8, line 8).

As per claim 15, Dick et al. further teaches a reset function (column 7, line 56).

As per claim 20, the combination of Cochran et al., Dick et al., and Kim et al. teaches all features of the claim as already discussed above.

Allowable Subject Matter

Claims 10-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc E. Norman whose telephone number is 571-272-4812. The examiner can normally be reached on Mon.-Fri., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Denise Esquivel can be reached on 571-272-4808. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

A handwritten signature in black ink, appearing to read 'Marc Norman', with a stylized flourish extending to the right.

MARC NORMAN
PRIMARY EXAMINER